

REMARKS

This Amendment and Response to Office Action is being submitted in response to the office action mailed May 21, 2002. The Examiner's comments have been carefully considered, and are addressed in the paragraphs which follow.

Objection to the Disclosure

The disclosure in the present application is objected to under 35 U.S.C. §112, 35 U.S.C. §162, and 37 C.F.R. §1.163 as failing to provide a reasonably complete botanical description of the claimed plant. The objection to the disclosure is followed by a highly detailed request for additional descriptive information regarding the new variety. The Examiner has not shown that the description of the new plant fails to distinguish the plant from its parent or from other known varieties.

The Examiner cites 35 USC 162 to support the objection and request for additional descriptive information.

35 USC 162 reads:

No plant patent shall be declared invalid for noncompliance with section 112 of this title if the description is as complete as is reasonably possible. . .

This statute acknowledges that an enabling written description cannot be provided for a plant, and so allows instead a *reasonably complete* description. Applicant asserts that for the purposes of a plant patent specification, a reasonably complete description identifies the novel, distinguishing, and non-variable characteristics of a new plant variety, and additionally points out commercially relevant and distinctive features of the variety. This assertion is borne out in 37 CFR 1.163(a):

The specification must contain as full and complete a

disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents.

A reasonably complete description *does not* include each and every quantifiable feature of the plant. While a highly detailed description may have merit for some purposes (breeding program records, botanical publications, researcher's notes, etc.), it is neither required by law nor appropriate in a plant patent application.

The grant of a plant patent is described in 35 USC 163:

In the case of a plant patent, the grant shall include the right to exclude others from asexually reproducing the plant, and from using, offering for sale, or selling the plant so reproduced, or any of its parts, throughout the United States, or from importing the plant so reproduced, or any parts thereof, into the United States.

The botanical description and illustrations included in a patent for a new plant variety, combined with the claimed plant itself (or its asexually produced progeny), define the invention in which exclusive rights are claimed. However, no amount of description, or lack thereof, will affect the scope of the claim in a plant patent. The claim of a plant patent includes the *specific plant*, including any of its parts, shown and described in the specification. No more, no less. By excluding variable and commercially irrelevant description from the specification, the applicant does not - can not - broaden the scope of the plant patent claim defined by the statute.

In order to enforce a plant patent against an infringer, "the patentee must prove that the alleged infringing plant is an asexual reproduction, that is, that it is the progeny of the patented plant." *Imazio Nurseries, Inc. v. Dania Greenhouses*, 69 F.3d 1560, citing *Yoder Bros., Inc. v. California-Florida Plant Corp.*, 537 F.2d 1347, 1390, 193 USPQ 264, 293. A highly detailed and exacting patent specification may be appealing to a botanist, a patent Examiner, or a patent applicant, but it

is not more useful or valuable in enforcing the exclusive rights of the patent owner than a reasonably complete specification that points out the distinguishing characteristics of the variety.

Many of the characteristics for which the Examiner has requested additional descriptive information are subject to substantial variability. Some of the variables which can affect the observable characteristics of fruit trees include: soil type; fertilizers and agricultural chemicals; weather; climate; watering; plant stress; cultural practices; and disease.

A quantitative recitation of variable characteristics fails as a "reasonably complete" description as required by the statute. Without taking into consideration the unique attributes of plants as patentable subject matter, one might conclude that if some description is good - reasonably complete - then more description must be better. In a utility patent application, this may be true. Devices, compounds and methods are described in terms of physical properties bound by physical laws. In order to enable the invention claimed in the utility application, it may be necessary to provide a quantitative recitation of the physical characteristics of the invention, in some cases with a high degree of precision.

In contrast, no such enabling description is required, or even possible, in a plant patent application. The botanical description in a plant patent application is intended to aid in identifying the claimed plant, not to enable the reader to make the invention. A botanical description which exceeds the reasonably complete standard by providing description of variable characteristics does not aid in identifying the plant, but in fact introduces vague and ambiguous information. Rather than serving to improve the quality of the disclosure in a plant patent application, the addition of unnecessary, vague or ambiguous information diminishes its value as an aid in identifying the claimed plant. Applicant asserts that a "reasonably complete" description of a plant is limited to non-variable

characteristics which are used by those skilled in the art to identify plants of the variety claimed.

The Manual of Patent Examining Procedure offers further instruction on what constitutes an appropriate description in a plant patent application:

The specification should include a complete detailed description of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents, expressed in botanical terms in the general form followed in standard botanical textbooks or publications dealing with the varieties of the kind of plant involved (evergreen tree, dahlia plant, rose plant, apple tree, etc.), rather than a mere broad nonbotanical characterization such as commonly found in nursery or seed catalogs.

A variety of botanical textbooks, plant encyclopedias, and horticultural publications have been consulted by the applicant's agent to compare examples of typical varietal descriptions of plants. After a careful review, applicant's agent has found that the botanical descriptions of plants found in relevant publications vary substantially in the level of detail and specificity provided. However, the "general form" of typical botanical descriptions of peach trees does not usually include quantified details such as the length, diameter, and coloration of the petiole; size and coloration of the reproductive organs; bud diameter; etc. as required by the examiner in this application. The specification provided by the applicant is well within the range of a reasonably complete description.

Applicant's agent has been made aware that the USPTO plant patent examining corps has developed a series of templates to which all new plant patent applications are compared, and by which all applications are measured. These templates have not been subject to review or discussion by the patent bar or the public, and their use in rejecting patent applications under 35 USC 112 is beyond the scope of the PTO's authority.

The obligations of an applicant for a plant patent are set forth in 35 U.S.C. §163, 37 C.F.R.

§1.163, and MPEP 1605. The applicant has met these obligations by providing a reasonably complete botanical description that describes the major characteristics of the new plant in botanical terms, and differentiates the new plant from its parents and from other known plant varieties.

The following paragraphs specifically address the Examiner's comments beginning at page 4 of the Office Action.

- A. The specification has been amended to incorporate a heading for the Latin name of the genus and species of the plant claimed as set forth in 37 C.F.R. §1.163(c)(4).
- B. Applicant declines to provide the information requested by the Examiner in this paragraph, for the reasons set forth above.
- C. Applicant declines to provide the information requested by the Examiner in this paragraph, for the reasons set forth above.
- D. Applicant declines to provide the information requested by the Examiner in this paragraph, for the reasons set forth above.
- E. Applicant declines to provide the information requested by the Examiner in this paragraph, for the reasons set forth above.
- F. Applicant declines to provide the information requested by the Examiner in this paragraph, for the reasons set forth above.
- G. At page 3, line 21, the applicant has described the leaf margin as "crenate", which describes a leaf "with rounded teeth along the margin" "Crenulate" refers to leaves "with very small rounded teeth along the margin." (See James G. Harris and Melinda Woolf Harris, "Plant Identification Terminology, An Illustrated Glossary", Spring Lake Publishing, 1994)(copy

of pertinent pages attached). Applicant declines to change the description of the leaf margin, as “crenate” most accurately describes the leaf margin.

- H. Applicant declines to provide the information requested by the Examiner in this paragraph, for the reasons set forth above.
- I. Applicant declines to provide the information requested by the Examiner in this paragraph, for the reasons set forth above.
- J. Applicant declines to provide the information requested by the Examiner in this paragraph, for the reasons set forth above.
- K. Applicant declines to provide the information requested by the Examiner in this paragraph, for the reasons set forth above.
- L. Applicant declines to provide the information requested by the Examiner in this paragraph, for the reasons set forth above.
- M. Applicant declines to provide the information requested by the Examiner in this paragraph, for the reasons set forth above.
- N. Applicant declines to provide the information requested by the Examiner in this paragraph, for the reasons set forth above.
- O. Applicant declines to provide the information requested by the Examiner in this paragraph, for the reasons set forth above.
- P. The specification has been amended at page 5, line 15 to clarify that the average stem length is 0.5 cm.
- Q. Applicant declines to provide the information requested by the Examiner in this paragraph, for the reasons set forth above.

- R. Applicant declines to provide the information requested by the Examiner in this paragraph, for the reasons set forth above.
- S. Applicant declines to provide the information requested by the Examiner in this paragraph, for the reasons set forth above.
- T. Applicant declines to provide the information requested by the Examiner in this paragraph, for the reasons set forth above.
- U. Applicant declines to provide the information requested by the Examiner in this paragraph, for the reasons set forth above.
- V. Applicant declines to provide the information requested by the Examiner in this paragraph, for the reasons set forth above.
- W. The Examiner has objected to the claim in the application on the basis that the inclusion of the language “and all its parts” is improper in a claim for a plant patent. Applicant has amended the claim as suggested by the Examiner.

The proper claim language requirements are specifically set forth in Section 162 of the Plant Patent Act as follows:

§ 162 Description, Claim

* * *

The claim in the specification shall be in formal terms to the plant shown and described.

Congress’s expansion of the scope of plant patent rights under the 1998 amendment of Section 163 does not require any change in the formal claim language of a plant patent as set forth in Section 162. There are two facts which support this interpretation of the Plant Patent Amendments

Act of 1998 (the “Act”). First, Congress expanded the scope of rights in plant patents by amending Section 163 to include the “. . . plant so reproduced, or any of its parts. . . ” (See Public Law 105-289, Section 3(a)), but did not amend the formal claim language requirement of Section 162. By expanding the enforceable scope of plant patents under Section 163, and by simultaneously not changing the formal claim language requirement under Section 162, Congress clearly evidenced an intent that Section 163 governed the enforceable scope of a plant patent without regard to formal claim language requirements set forth in Section 162.

Second, Congress specified that expansion of the scope of enforceable rights under the Section 163 in the Act applied to “. . . any plant patent issued on or after the date of the enactment of this Act.” Public Law 105-289, Section 3(b). The Act was signed by the President and enacted on October 27, 1998. The Act thus applied retroactively to those applications filed before the enactment date, but which issued after the enactment date. Application of the Act to the following hypothetical situation further makes it clear that Congress intended to sever the historical connection between the formal claim language required by Section 162 and the enforceable scope of a plant patent under Section 163:

A plant patent application filed in December of 1996 (before the existence of the Act was ever even contemplated), contained the traditional formal claim language required by Section 162, and subsequently issued as Plant Patent No. 8,888 on November 1, 1998, without any change in the claim language during prosecution of the application. Despite the fact that the ‘888 applicant never made a change to the claim language, the Act expanded the enforceable scope of that issued ‘888 plant patent to include “parts of the plant” rather than only the “whole plant” which was protected prior to the Act.

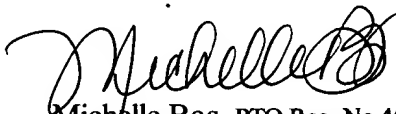
Accordingly, applicant agrees with the Examiner that the words “, including all of its parts” should be deleted from the claim. Thus amended, the claim complies with the Section 162 “formal

language” requirement. It is clear that Section 163 of the Act offers a uniform scope of protection to all plant patents, regardless of the claim language. It is applicant’s belief and intent that eliminating the superfluous “including all of its parts” language in the claim still enables the applicant to enforce any patent which issues from this application against those infringers who are using, offering for sale, selling, or importing parts of the plant claimed in this application.

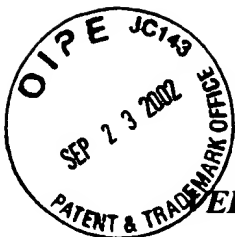
CONCLUSION

Based on the foregoing amendment and remarks, the Applicant believes the application is now in condition for allowance. Such action is respectfully requested. If there are any remaining issues which could be addressed by telephone, the examiner is invited to contact the Applicant's representative who signs below.

Respectfully Submitted,



Michelle Bos, PTO Reg. No.45,499
STRATTON BALLEW PLLC
213 South 12th Avenue
Yakima, WA 98902
Telephone (509) 453-1319



Part/#4

VERSION WITH MARKINGS TO SHOW CHANGES MADE

TITLE: PEACH TREE NAMED 'GL4/66'

LATIN NAME: *Prunus persica* L. Batsch

ORIGIN OF THE VARIETY

The present new and distinct variety of peach tree [*(Prunus persica)*] was originated from an open pollinated population of seedlings derived from the variety 'Yumyeong' planted in 1990 at the HortResearch experimental orchard in Havelock North, New Zealand. Paul G. Glucina established a large group of open-pollinated seedlings on their own roots and under careful observation one seedling representing the present variety was selected and asexually propagated for further evaluation by Michael T. Malone. The selection was further propagated by asexual reproduction for the first time in 1995.

ASEXUAL REPRODUCTION OF THE VARIETY

The new variety was budded onto 'Golden Queen' peach rootstock and shows the unique combination of characteristics and distinctive colour are true to the original seedling tree and are transmitted through succeeding asexual generations.

SUMMARY OF THE VARIETY

The described variety of peach tree is of a medium to large size, vigorous, with a spreading growth habit. It is a regular and productive bearer of medium to large white flesh, clingstone fruit with a sweet sub-acid taste and very firm crisp flesh with good fruit aroma. The fruit has very good flavour and eating quality. The firm flesh exhibits good storage and the skin



Rounded, medium to deep, average depth 9
mm, average width 28 mm

Flesh

Ripening

Even

Texture

Firm, non-melting

Fibres

Non-fibrous

Aroma

High

Eating Quality

Good

Flavour

Low acid, mild

Soluble Solids

Average 10-12° Brix

Juice

Moderately juicy

Colour

White 155D

Anthocyanin

Low

Stem

Size

Medium, average length 0.5 cm

Colour

Yellow green 150C

Skin

Thickness

Medium

Texture

Medium to strong adherence of skin to flesh

Density of Pubescence

Medium

Tendency to Crack

None

Colour

Red 46A, blending to dark pink 48A blush

CLAIM

We claim:

A new and distinct variety of peach tree named 'GL4/66,' [including all its parts and the fruit thereof,] substantially as illustrated and described.

ABSTRACT

A new and distinct variety of peach tree (*Prunus persica* L. Batsch) named 'GL4/66,' a selection derived from the open pollinated seed of 'Yumyeong' (not patented), is described. The new variety is distinguishable from the parent variety by its early harvest maturity, two weeks earlier than 'Yumyeong,' and by its sweeter, more aromatic fruit. A further distinction between 'GL4/66' and 'Yumyeong' is the higher chill requirement of the new variety. Its novelty consists of a unique combination of features that include late flowering, heavy and regular cropping, larger very firm, white crisp-textured, clingstone fruit with a pale pink overcolour. The fruit have a sweet, sub-acid flavor with very good fruit aroma.

IDENTIFICATION
TERMINOLOGY
Annotated Glossary



BEST AVAILABLE COPY

BEST AVAILABLE COPY

PLANT IDENTIFICATION TERMINOLOGY: AN ILLUSTRATED GLOSSARY. Copyright © 1994 by James G. Harris and Melinda Woolf Harris. All rights reserved. Printed in the United States of America. No part of this book may be reproduced in any form, electronic or mechanical, including photocopying, recording, or by any information storage and retrieval system, without the prior written permission of the publisher. For information address Spring Lake Publishing, P.O. Box 266, Payson UT 84651.

First Printing 1994
Second Printing 1995
Third Printing 1995
Fourth Printing 1996
Fifth Printing 1997

Publisher's Cataloging in Publication Data

Harris, James G., 1954-

Harris, Melinda Woolf, 1953-

Plant identification terminology: an illustrated glossary / James G. Harris & Melinda Woolf Harris
x, 198 p.: illus.; 26 cm.

ISBN 0-9640221-5-X (alk. paper)

1. Botany--Dictionaries. 2. Botany--Terminology. I. Title.

QK9.H37 1994

580.3 H242

94-65026

tion of a



25



ROLLA TUBE

26

ridges.

or ridge.



DOWN-LIKE
PAPPUS

28



30

tween the

epidermis and the stele. Figure 231.

Cortical. Of or pertaining to the cortex.

Corymb. A flat-topped or round-topped inflorescence, racemose, but with the lower pedicels longer than the upper. Figures 232 and 233.

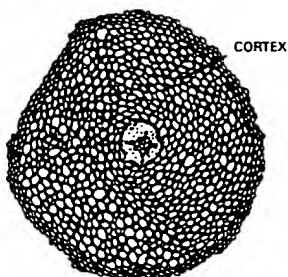


Figure 231

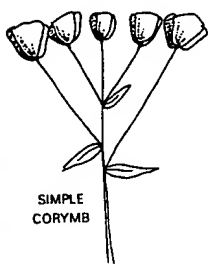


Figure 232

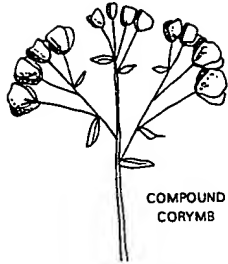


Figure 233

Corymbiform. An inflorescence with the general appearance, but not necessarily the structure, of a true corymb.

Corymbose. Having flowers in corymbs. The term is sometimes used in the same sense as corymbiform.

Costa (pl. costae). A rib or prominent mid-vein. Figure 234.

Costate. Ribbed. Figure 234.

Costular. Pertaining to the ribs or veins.

Cotyledon. A primary leaf of the embryo; a seed leaf. Figures 235 and 236.

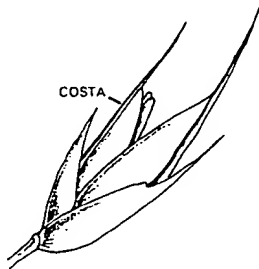


Figure 234

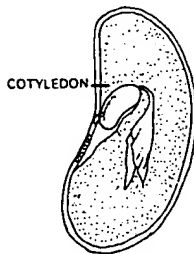


Figure 235

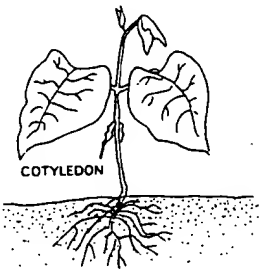


Figure 236

Cotyliform. Cup-shaped. Figure 237.

Crateriform. Bowl-shaped. Figure 237.

Creeping. Growing along the surface of the ground, or just beneath the surface, and producing roots, usually at the nodes. Figure 238.



Figure 237

Cremocarp. See schizocarp.

Crenate. With rounded teeth along the margin. Figure 239.

Crenation. A rounded projection or tooth along the margin of a leaf. Figure 239.

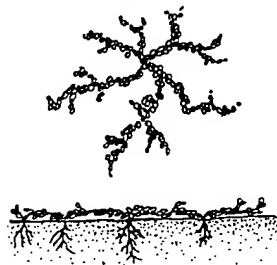


Figure 238

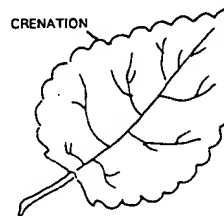


Figure 239

Crenature. See crenation.

Crenulate. With very small rounded teeth along the margin. Figure 240.

Crenulation. A very small rounded tooth along a margin; a minute crenation. Figure 240.

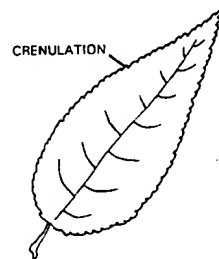


Figure 240

Creosote. An oily liquid with a strong, penetrating odor.

Crest. An elevated ridge or rib on a surface. Figure 241.

Crested. With a crest, usually on the back or at the summit. Figures 241 and 242.

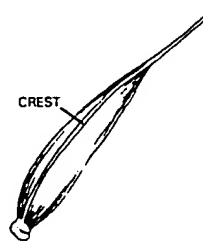


Figure 241

BEST AVAILABLE COPY